

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-14 are currently pending. Claims 15-28 are canceled without prejudice or disclaimer. Claims 1-5, 8, 10, and 13-14 are amended to clarify features previously presented. No new matter is added.

In the outstanding Office Action, Claims 1-14 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

With regard to method Claims 2 and 14, Applicants submit that the first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 U.S.C. § 101 (process, machine, manufacture and composition of matter). Claims 2 and 14 are each directed to a process.

A process has been given specialized meaning.¹ Based on Supreme Court precedent, recent Federal Circuit decisions, and guidelines of the Office, a 35 U.S.C. § 101 process must (1) be tied to another statutory class or (2) transform underlying subject matter to a different state or thing. Applicants submit that Claims 2 and 14 each qualify as a § 101 statutory process, as each of these claims positively recite another statutory class to which it is tied, by identifying the information processing apparatus and component portions of the apparatus that accomplish the method steps of these claims. Determining whether a claimed invention is directed to a statutory category of invention is a separate step from whether the claimed invention falls within a judicial exception and whether the invention is limited to a specific practical application of a judicial exception. Therefore, as the claimed methods are a

¹ See USPTO Memorandum to Technology Center Directors, dated May 15, 2008, Clarification of "Processes" under U.S.C. § 101. [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_101_05_15_2008.pdf]

statutory subject matter eligible process, the inquiry to determine whether the claimed invention falls within a judicial exception is misguided.

With regard to Claim 3, this claim is amended to recite a computer readable storage medium in view of MPEP § 2106.

With regard to Claims 1 and 4-13, Applicants note that Claims 1 and 4-13 are directed to an information processing apparatus and recite means-plus-function terminology.

Proper claim interpretation of a means-plus-function (35 U.S.C. § 112, 6th paragraph) element entails consideration of the structures disclosed in the specification and equivalents thereof. In determining the scope of the claims prior to determining compliance with each statutory requirement for patentability, MPEP § 2106 provides:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describes the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that office personnel will correctly interpret each claim limitation. (Emphasis added).

Thus, Applicants respectfully submit that the rejection under 35 U.S.C. § 101 of at least Claims 1 and 4-13 is improper as these claims clearly recite means plus function claim features.

Moreover, MPEP § 2106 provides that:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitations to a practical application in a technological arts should it be rejected under 35 U.S.C. § 101 . . . Further, when such a rejection is made, office personnel must expressly state how the language of the claims has been interpreted to support the rejection. (emphasis added) See MPEP § 2106.

Accordingly, should such a rejection be maintained in a subsequent communication with respect to any of the aforementioned claims, Applicants respectfully request the Examiner provide an express statement on the record in accordance with MPEP § 2106

guidelines explaining how such claim terminology, such as “information acquisition means,” “information storage means,” “information processing means,” “information display control means,” “IC card detection means,” and “type discrimination means” are interpreted. More specifically, Applicants respectfully request the Examiner provide an express statement explaining how such limitations are deficient to define a statutory apparatus.

Accordingly, for all of the above reasons, Applicants respectfully request that the rejection of Claims 1-14 under 35 U.S.C. § 101 be withdrawn.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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